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10/596,752	12/08/2008	Martin Imhof	MEISS71.028APC	1141

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EXAMINER

HOFFMAN, MARCIA

ART UNIT	PAPER NUMBER
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3774

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/596,752	Applicant(s) IMHOF, MARTIN	
	Examiner MARCIA HOFFMAN	Art Unit 3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-25 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10 and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 5-25 are pending. Claim 11 is withdrawn from consideration.
2. Objections to claims 5 and 9 are withdrawn in view of Applicant's amendment.

Response to Arguments

3. 35 U.S.C. 112, second paragraph, rejection of claims 7-10 is withdrawn in view of Applicant's amendment.
4. Double patenting rejection over U.S. Patent No. 4,894,064 is withdrawn.
5. Applicant's arguments with respect to claims 5-10 have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant argues "that Serbousek's liner 14 and shell 12 do not contact in the spherical region." This argument is speculative, failing to be based on factual evidence. The figures, on the other hand, disclose contact in the spherical region between liner 14/16 (60) and shell 12 (figures 2-4). It is further noted by the Examiner that paragraph [0039] of Serbousek describes a structure in which there is no relative movement. As such, Serbousek appears to imply no space/gap is present between the liner and shell. Thus, Applicant's argument is not persuasive.
7. Additionally, Applicant argues Serbousek fails to anticipate the claimed invention because it would require substantially perfect tolerances for contact to occur. However, Serbousek discloses the claimed invention, despite possible manufacture difficulties. The Applicant is additionally reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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8. Also, the Examiner notes that in the liner 14/16 (60) and shell 12 of Serbousek the line of contact is surrounded by and intersects the spherical outer surface” (at the very least at a point during a moment in time) (figures 2-4).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5-10, 12, 14-17 and 19-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Serbousek et al. U.S. publication no. 2002/0068980.

11. Regarding claims 5 and 19-20, Serbousek et al. disclose a joint socket (10) for a hip endoprosthesis, comprising: a socket shell (12) configured to be implanted in the pelvic bone of a patient (paragraph [0029], lines 3-4), the socket shell having an inner surface (20) that defines an accommodating space (24) extending about an axis of rotation; and a socket insert (60) configured to provide a bearing (16) (paragraph [0032], lines 1-2) for a joint head of a prosthesis stem, a spherical outer surface (32) of the socket insert configured to be disposed in the accommodating space of the socket shell (paragraph [0029], line 5) and configured to contact the inner surface of the socket shell along a line of contact that is concentric with the axis of rotation of the accommodating space (figure 3) and is surrounded by and intersects the spherical outer surface (at the very least for a moment in time at a single point) (figures 2-4), the socket insert coupleable in a self-locking manner within the accommodating space (paragraph [0035]), wherein the inner surface of the socket shell tapers toward a pole of the shell (via taper 30) in the

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region of the line of contact in such a manner that a radius of curvature in the region is greater than the spherical radius of the outer surface of the socket insert (figures 2-4, where it is understood that the socket shell tapers toward the pole of the shell in the region of the line drawn along the contact of the shell and insert such that a radius of curvature in the region of the taper is greater than the spherical radius of the outer surface of the socket insert).

12. Regarding claims 6 and 21, Serbousek et al. disclose the inner surface has a conical shape (paragraph [0034], lines 8-9) and defines an infinite radius of curvature in the region of the line of contact (figures 2-3, where it is understood that the tapered regions of element 20 define a conical shape, while the area of contact further defines an infinite radius of curvature because it is circular).

13. Regarding claims 7 and 22, Serbousek et al. disclose a cone angle of the conically shaped inner surface is a self-locking angle (paragraph [0035], lines 5-11) corresponding to a material pairing of the socket shell and the socket insert (paragraph [0033], where it is understood that material pairing is necessary in combining materials and interlocking components and would thus also be necessary in affixing shell and liner).

14. Regarding claims 8 and 23, Serbousek et al. disclose the cone angle of the conical inner surface is between about 4° and 10° (paragraph [0035], where it is understood that between about 4° and 10° is encompassed within the range of zero and seventeen degrees).

15. Regarding claims 9 and 24, Serbousek et al. disclose the cone angle of the conical inner surface is about 4.5° (paragraph [0035], where it is understood that about 4.5 degrees is an acute angle falling within the specific range of zero degrees to seven degrees).

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16. Regarding claims 10 and 25, Serbousek et al. disclose the cone angle of the conical inner surface is about 9.5° (paragraph [0035], where it is understood that about 9.5° is an acute angle falling within the specific range of zero degrees to seven degrees).

17. Regarding claim 12, Serbousek et al. disclose the joint socket and the joint insert are configured to allow free rotation and tilting of the insert in the socket shell (paragraph [0040], lines 7-10)-- when inserting, removing or positioning, i.e. at a point in time wherein the shell and liner are not fully locked into place (figures 2-4).

18. Regarding claim 14, Serbousek et al. disclose the socket shell is configured to be fixed in a bone by one or more screws (figures 7-9, where it is understood that the socket shell is configured such that it can be fixed in a bone by one or more screws --paragraphs [0041]-[0042]-, wherein the use of bone screws to secure a socket shell is well-known in the art).

19. Regarding claim 15, Serbousek et al. disclose an alternate embodiment of figures 7-15 that operates according to the principles of the embodiment of figures 1-6 (paragraphs [0041] and [0048]-[0049]). In this embodiment, the accommodating space comprises a generally flat base (figures 7-9).

20. Regarding claim 16, Serbousek et al. disclose the socket insert is a metallic socket insert (paragraph [0031], lines 13-14).

21. Regarding claim 17, Serbousek et al. disclose the socket insert is a ceramic socket insert (paragraph [0031], lines 13-15).

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serbousek et al. in view of Shelley U.S. patent no. 4,997,447.

24. Regarding claim 13, Serbousek et al. disclose at least a portion of an outer surface of the socket shell comprises a mechanism to further facilitate fixation of the shell (paragraph [0042], lines 10-13). However, Serbousek et al. are silent regarding the mechanism to further facilitate fixation of the shell comprises a threaded portion over at least a portion of an outer surface of the socket shell. It is well-known in the art to use a threaded portion over at least a portion of an outer surface of the socket shell to further facilitate fixation of the shell. Shelley teaches a threaded portion over at least a portion of an outer surface of the socket shell (figure 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the outer surface socket shell threaded portion, as taught by Shelley, in the invention disclosed by Serbousek et al. in order to further facilitate fixation of the shell in the acetabulum.

25. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serbousek et al.. Regarding claim 18, Serbousek et al. disclose the line of contact is spaced at varying axial depth from the mouth of the opening of the accommodating space (paragraph [0029], lines 23-24). However, Serbousek et al. is silent regarding the line of contact is spaced between about 5mm and 15mm from an opening of the accommodating space. It would have been obvious to one of ordinary skill in the art at the time of the invention to space the line of contact between about 5mm and 15mm from an opening of the accommodating space, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or

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workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It is further noted by the Examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to space the line of contact between about 5mm and 15mm from an opening of the accommodating space, since Applicant has not disclosed that spacing the line of contact between 5mm and 15mm solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a line of contact that is spaced at varying axial depths from the mouth of the opening of the accommodating space.

Double Patenting

26. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

27. Claims 5-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-28 of copending Application No. 12/296796. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the present application and copending application are drawn to a joint socket for a hip joint endoprosthesis, comprising: a socket shell configured for implantation in a bone and comprising a receiving space comprising an inner face; and a socket insert coupleable to the socket shell and configured to accommodate a joint head of a hip prosthesis stem therein, the socket insert comprising a spherical portion comprising a spherical outer face, the spherical portion configured to be received by the receiving space so that the spherical outer face and inner face contact each other concentrically with a rotational axis of the socket shell, the radius of curvature of the inner face being greater than the radius of curvature of the spherical portion in a region of concentric contact, such that the spherical portion self-lockingly clamps in the receiving space.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCIA HOFFMAN whose telephone number is (571) 270-1456. The examiner can normally be reached on Monday thru Friday, 10:00 a.m. - 6:00 p.m., Est. (alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on (571) 272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCIA HOFFMAN/
Examiner, Art Unit 3774

/William H. Matthews/
Primary Examiner, Art Unit 3774